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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,215	09/24/2003	Valerie Sue Adams	71553	4646

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/669,215

Applicant(s)

ADAMS ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 and 28-45 is/are pending in the application.
- 4a) Of the above claim(s) 43-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 28-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Applicant's election with traverse of I in the reply filed on 4/25/05 is acknowledged. The traversal is on the ground(s) that there is no burden on the examiner to examine all the claims and the search for is coextensive for both groups. This is not found persuasive because the search is not coextensive. A search for claim 43's polyester does not require a search for blends of polyester with polycarbonate. Secondly, the polyester defined by claim 43 has many limitations not present in the claim 1's blend of polycarbonate with a broadly defined polyester. Patentability of claim 43's polyester does not determine if claim 1's blend is patentable.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-10, 12, 15-20, 31-37, 39, 40 and 42 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Sublett '944 Patent.

Sublett suggests blends of polycarbonate with polyester (column 2, lines 4-6). The polyester is based on dimethyl terephthalate, cyclohexane dimethanol and optionally ethylene

glycol (column 2, lines 11-15). The catalyst for making the polyester is present in amounts to provide 10-100 ppm titanium (column 2, line 20).

A phosphate may also be present in the catalyst system (column 2, line 41).

Claims 1-4, 7-10, 12, 15-20, 31-37, 39, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sublett '944 Patent in view of Hamilton '816 or the Smith Article in Journal of Applied Polymer Science.

Sublett suggests a range of titanium amounts, but does not point out advantages in picking the lower end amounts.

Hamilton (column 1, lines 24-31; column 2, line 59) and Smith (page 4237) explain residual titanium catalyst from the polyester negatively affects polyester/polycarbonate blends.

One of ordinary skill seeking to minimize these problems would choose lesser amounts of catalyst when producing the polyester.

Claims 1-10, 12-20, 31-40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sublett '944 Patent in view of Small '610 optionally in further view of Hamilton '816 or the Smith Article.

Sublett does not suggest adding distearyl pentaerythritol diphosphate to the PC/polyester blend.

This and other phosphates are known to improve the melt stability of PC/polyester blends (column 2, lines 26; column 4, line 5 of Small). It would have been obvious to add these phosphites to Sublett's blend for the expected improvements.

Hamilton and Smith can be relied on to choose low amounts of titanium catalyst as previously explained.

Claims 1-13, 15-26, 28-37 and 39-42 rejected under 35 U.S.C. 103(a) as being unpatentable over the Allen '692 Patent in view of Hilbert '133.

Allen blends polycarbonate with polyester (abstract). The polyester can be based on cyclohexaned dimethanol, ethylene glycol and terephthalic acid (column 9, line 3) in the ratios preferred by applicant in claim 20. Alternatively, the polyester can be based on cyclohexane dimethanol, isophthalic acid and terephthalic acid (column 10, line 3) in the ratios preferred by applicant in claim 21. Various catalysts can be used (column 7, line 67) to polymerize the polyester, but Allen does not describe the amount of titanium.

Hilbert discloses such a low titanium catalyst system for making polyesters (column 2, line 57). Furthermore, Hilbert's catalyst system includes a combination of toners (column 5, lines 31-40) and phosphorous (column 2, line 61).

It would have been obvious to use Hilbert's catalyst system when making the polyester of Allen's polyester/PC blend. This low-level titanium catalyst system would be expected to minimize the well-known problems associated with residual titanium in polyester/PC blends.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-26 and 28-42 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6723768. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent also claims blends of polyester with polycarbonate where the polyester is made with a small amount of titanium catalyst. The instant claims are broader in the sense that toner copolymerizable monomers are not required.

Adams '918 is cited for its low titanium catalyst system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner
DAVID J. BUTTNER
PRIMARY EXAMINER

5/6/05

